In the Supreme Court of the United States

OCTOBER TERM, 1940.

No. .....

KENNETH S. CLAPP,
Plaintiff-Petitioner,

vs.

STEWART-WARNER CORPORATION,
Defendant-Respondent.

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

OPINIONS OF THE COURTS BELOW.

The Opinion of the Circuit Court of Appeals for the Seventh Circuit, on the appeal in the case at bar, is reported at 116 Fed. 2nd 68 and is included in the Transcript of Record (R-II 1039, a copy also being attached as an appendix to this brief).

The Oral Opinion of the District Court for the Northern District of Illinois is included in the Transcript of Record (R-II 664), and the Findings of Fact and Conclusions of Law entered by the District Court are also included in the Transcript of Record (R-II 650-663).

JURISDICTION.

The grounds on which the jurisdiction of this Court is invoked, are:

1. The date of the judgment to be reviewed was December 5, 1940. (R-II 1046.)

2. The judgment was rendered in a suit in equity brought under the Patent Statutes to determine the issues of validity and infringement of letters patent for invention issued by virtue of Section 4886 (U. S. C. Title 35, Sec. 31) and Section 4888 (U. S. C. Title 35, Sec. 33) of the Revised Statutes of the United States.

3. The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code (U. S. C. Title 28, Sec. 347).

4. Cases sustaining jurisdiction are:

Lincoln vs. Stewart-Warner, 303 U. S. 545;
(conflict with applicable decisions of this Court)
Carbice vs. American Patents Development, 283 U. S. 27;
Armstrong vs. Nu-Enamel Corporation, 305 U. S. 315
(importance of point of law involved).

STATEMENT.

The facts are sufficiently stated in the Petition.

STATUTES.

The statutes under which this case arises and which are necessary to be considered are Section 4886 (U. S. C., Title 35, Sec. 31) and Section 4888 (U. S. C., Title 35, Sec. 33) of the Revised Statutes of the United States.

Section 4886 of the Revised Statutes reads as follows:

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than

one* year prior to his application, and not in public use or on sale in this country for more than one* year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Section 4888 of the Revised Statutes reads as follows:

"Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and **he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.** The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

SPECIFICATION OF ERRORS.

The errors, which the petitioner will urge if the writ of certiorari is allowed, are the following:

1. The Court of Appeals for the Seventh Circuit erred in holding Baldner patent claims 2, 3, 4 and 13 not infringed by the manufacture, use and sale of the defendant-respondent's "Rock-Crusher" grease-compressors.

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* Two years for applications filed prior to August 5, 1940. Statute changed from two years to one year by Act of Congress on August 5, 1939 and effective one year later.

2. The Court of Appeals for the Seventh Circuit erred in holding that infringement of Baldner claims 2, 3, 4 and 13 is avoided by the fact that the defendant-respondent's "Rock-Crusher" grease-compressors are always sold and used with a delivery hose attached, the hose being fitted at its forward end with a coupler by which it is attachable to an automobile fitting.

3. The Court of Appeals for the Seventh Circuit erred in holding that infringement of Baldner claims 2, 3, 4 and 13 is avoided by the fact that a pressure may be built up in the grease hose (with which the "Rock-Crusher" is always sold and used) upon the meeting of external resistance by the flow of grease through the hose, coupler and fitting.

4. The Court of Appeals for the Seventh Circuit erred in holding that Baldner claims 2, 3, 4 and 13 directed to an improved grease-compressor *per se* are not infringed by defendant-respondent's equivalent grease-compressor to which is always added, in sale and use, a hose having a coupler on its end adapted to be attached to an automobile fitting.

5. The Court of Appeals for the Seventh Circuit erred in holding, in effect, that the inventor of an improved grease-compressor must include in his patent claims the old elements of a hose, a coupler and a fitting of an old and well understood aggregation in order to protect his improved grease-compressor wherein the invention resides.

6. The Court of Appeals for the Seventh Circuit erred in holding, in effect, that claims drawn to an old aggregation of a grease-compressor hose, coupler and fitting are the only type of claims which can protect an invention in a new improved grease-compressor *per se*.

7. The Court of Appeals for the Seventh Circuit erred in holding, in effect, that claims which would include an improved grease-compressor, an old hose, an old coupler and an old fitting in an old and well understood aggrega-

tion would be valid and would thus protect the improved grease-compressor when sold and used with an old hose, an old coupler and an old fitting.

8. The Court of Appeals for the Seventh Circuit erred in holding that infringement of Baldner claims 2, 3, 4 and 13 is avoided by the fact that defendant-respondent's "Rock-Crusher" grease-compressors do not have a meter or gauge of any kind added to its structure.

9. The Court of Appeals for the Seventh Circuit erred in holding that infringement of Baldner claims 2, 3, 4 and 13 is avoided by the fact that the accused "Rock-Crusher" does not include in its structure any means of counting or indicating the total number of charges of grease dispensed.

10. The Court of Appeals for the Seventh Circuit erred in holding that Baldner has no patent on anything less than his entire combination.

11. The Court of Appeals for the Seventh Circuit erred in holding that the accused "Rock-Crushers" avoid the charge of infringement because they do not include a meter, gauge or other counting or indicating mechanism in face of the fact that the claims in suit do not include, nor has it been asserted or found that they do include, any such meter, gauge or other counting or indicating mechanism.

12. The Court of Appeals for the Seventh Circuit erred in depriving the plaintiff-petitioner of the protection provided by the patent statutes as construed by this Court.

13. The Court of Appeals for the Seventh Circuit erred in holding that valid Baldner claims 2, 3, 4 and 13 directed to only a part of the entire combination disclosed in the entire specification do not protect the invention in that part from being bodily appropriated by the defendant-respondent.

14. The Court of Appeals for the Seventh Circuit erred in not reversing the decree of the District Court.

15. The Court of Appeals for the Seventh Circuit erred in not holding the Baldner patent infringed by the defendant-respondent.

16. The Court of Appeals for the Seventh Circuit erred in failing to grant the relief prayed for in the plaintiff-respondent's Bill of Complaint.

SUMMARY OF ARGUMENT.

Argument on First Conflict:

The Seventh Circuit Court of Appeals has erroneously decided in the present case that an owner of a patent can not recover for patent infringement, even though the accused grease-compressor and the patented, new improved grease-compressor are equivalent, element for element, and even though the claims in issue are unanticipated and admittedly valid, because, and for the sole reason that, the claims are confined to the vital part of the equipment; to wit, the new improved grease-compressor, and do not include an old aggregation of a grease-compressor, hose, coupler and fitting, as sold and used by the defendant-respondent. The above decision is directly contrary to the decisions of this Court in *Rogers vs. Alemite* (298 U. S. 415) and *Lincoln vs. Stewart-Warner* (303 U. S. 545).

Argument on Second Conflict:

Notwithstanding the fact that (1) the Baldner claims in suit are valid and unrestricted by the prior art, (2) the Baldner machine and the accused machine are mechanical equivalents, and (3) the claims in suit "read on" the accused machine, element for element, the Seventh Circuit Court of Appeals exonerated the accused "Rock-Crushers" upon the erroneous ground that the "entire specification" is the measure for the patented invention rather than the claims and that the patent does not protect from infringement anything other than the "entire combination" disclosed in the "entire specification." The Court of Ap-

peals disregarded the claims in suit and took the "entire specification" as the measure of the patent, contrary to the principle repeatedly enunciated by this Court in the case of *Continental Paper Bag Co. vs. Eastern Paper Bag Co.* (210 U. S. 405), the case of *Leeds and Catlin vs. Victor Talking Machine Co.* (213 U. S. 301), the case of *Altoona Theaters vs. Tri-Ergon Corp.* (294 U. S. 477) and other cases.

ARGUMENT.

The two grounds of conflict between the decision of the Seventh Circuit Court of Appeals and the fundamental principles of patent law as firmly established by the decisions of this Court are discussed here in the order followed in the foregoing Petition.

Argument On the First Conflict.

This Court has explicitly held that claims drawn to an old aggregation or exhausted combination of a grease-compressor, hose, coupler and automobile fitting, are invalid and improper as an attempt to create an unlawful monopoly beyond the actual invention. The Circuit Court of Appeals for the Seventh Circuit has nevertheless decided in the case at bar that claims drawn to an old aggregation of a grease-compressor, hose, coupler and fitting are the *only* type of claims which can protect an invention in a new grease-compressor and that claims confined solely to the new improved grease-compressor *per se* are avoided and are not infringed by an equivalent grease-compressor to which are added, as sold and used, a hose, coupler and automobile fitting.

In other words, the Seventh Circuit Court of Appeals has erroneously decided in the present case that an owner of a patent can not recover for patent infringement, even though the accused grease-compressor and the patented, new improved grease-compressor are equivalent, element for element, and even though the claims in issue are un-

anticipated and admittedly valid, because, and for the sole reason that, the claims are confined to the vital part of the equipment; to wit, the new improved grease-compressor, and do not include an old aggregation of a grease-compressor, hose, coupler and fitting, as sold and used by the defendant-respondent.

This Court, in the case of *Rogers vs. Alemite,* ruled adversely upon the validity of claims which included:

> "The claimed combination is, therefore, of four things: (1) a type of pin fitting which was old in the art; (2) a pump for creating pressure, which was old; (3) a hose to connect the two; and (4) a well known type of coupler." *Rogers vs. Alemite,* 298 U. S. 415, 419.

In the *Rogers* case the invention resided in a small, improved hose coupler while in the present case the invention resides in a large, power driven, improved grease-compressor, both the improved hose coupler and improved grease-compressor being usable in an old and well understood aggregation. The question of the proper manner to claim an improvement in a hose coupler or an improvement in a grease-compressor was discussed and decided by this Court as follows:

> "While Gullborg's invention was confined to an improvement in the hose coupler, which is but one element in the old and well understood combination of a compression chamber or pump, a hose, a hose-coupler, and a grease cup or fitting connected to the bearing to be lubricated, his claims are not for the improvement as such but all are for a *combination of the old elements* with the improved form of coupler.
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> "The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this *cannot be done* is shown

by numerous cases in this and other federal courts." *Rogers vs. Alemite,* 298 U. S. 415, 419, 425.

The same question was presented a *second* time to this Court in an appeal from the Seventh Circuit Court of Appeals, wherein the present defendant-respondent was again a party, in the case of *Lincoln vs. Stewart-Warner.* In deciding the *Lincoln vs. Stewart-Warner* case, this Court reaffirmed the decision of the *Rogers* case and again condemned the practice of attempting to obtain an unwarranted monopoly by claiming the old aggregation of grease-compressor, hose, coupler and automobile fitting when in fact the invention resided in only one of those four elements. This Court again discussed, re-iterated and decided the same fundamental principle of patent law as is presented in the case at bar, in the following unmistakable language:

> "Like that in the *Rogers* case, the patent in suit has to do with apparatus for lubricating bearings, especially those of automobiles, by the use of a nipple or fitting connected with the bearing, a gun consisting of a compressor or pump for propelling the lubricant under high pressure, a hose or conduit to connect the pump with the fitting, and a means of coupling the conduit to the fitting to make a tight joint during the operation of greasing.
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> "Butler's alleged invention is in the same field and deals with similar apparatus as did Gullborg's patent, considered in the *Rogers* case. As there shown, it was old practice in the lubrication of bearings to use in combination a fitting connected with the bearing through which oil or grease was to be propelled into the bearing and a gun, which was joined to the fitting by a coupler.
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> "As we said of Gullborg in the *Rogers* case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function

> in his claimed combination. The patent is therefore void as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination.
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> "We conclude that Butler's effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of chuck or coupler to old parts or elements having no new function when operated in connection with the coupler renders the claim void." *Lincoln vs. Stewart-Warner,* 303 U. S. 545, 546, 549, 552.

In the face of, and in opposition to, the established and fundamental principle of patent law so clearly and definitely stated by this Court, the Circuit Court of Appeals for the Seventh Circuit in the case at bar has decided that the accused "Rock Crusher" grease-compressors are to be exculpated and freed from infringement because:

> "They are always *sold and used* with a delivery hose attached, the *hose* being fitted at its forward end with a *coupler* by which it is attachable to the lubricant fitting." (R-II 1044.)

Thus, the Seventh Circuit Court of Appeals has penalized the patentee and deprived the owner of the patent of the protection granted by the patent laws for a new and useful invention simply because the patent claims are drawn to the improved grease-dispenser *per se* in line with the law enunciated by this Court rather than in accordance with the erroneous proposition *now twice* advanced by the Seventh Circuit Court of Appeals and for which it has already been expressly reversed by this Court in the case of *Lincoln vs. Stewart-Warner.*

Not unlike the facts in the case of *Lincoln vs. Stewart-Warner,* an endeavor has been made in this case to attribute some new function to the hose in the old aggregation. In the *Lincoln vs. Stewart-Warner* case, this present defendant-respondent vainly attempted to advance a similar contention by arguing that the hose introduced some new intangible function into the Butler coupler, producing a combination instead of an aggregation. This Court refused to be misled by such an erroneous theory and in answer thereto said:

> "The weakness of the respondent's position is well illustrated by what developed at argument. When interrogated as to how in the claimed combination the function of the nipple could be thought novel in any different sense than the function of the pump, counsel replied that the pump performed a novel function because the pressure it generated forced forward the piston in the coupler and caused the movable jaws to engage the fitting. If this argument is sound, the respondent may convict every one who sells a grease pump of contributory infringement. The answer is the same as in the case of the headed nipple. The function of a pump has always been to force a fluid or a grease through a conduit. The fact that this function of the pump is utilized in Butler's improved form of coupler not only to convey the lubricant to the bearing but to operate the jaws of the chuck does not alter the function of the pump." *Lincoln vs. Stewart-Warner,* 303 U. S. 545, 551.

However, the Seventh Circuit Court of Appeals, apparently unrestrained by this Court's prior decision, proceeded to exonerate from infringement the defendant-respondent's "Rock Crusher" because of the hose attached to the "Rock Crusher" and the pressure which may be built up in the hose by reason of external resistance offered to the flow of the discharged grease. A quotation from the decision of the Circuit Court of Appeals, bearing upon this point, is as follows:

"Continued operation of the motor will pump grease through the *hose* into the *fitting* through which the automobile bearing is lubricated. *If* the moving lubricant meets with *resistance* because of dirt, rust or dried grease in the *fitting* or bearing, the motor will compress the grease until the resistance is overcome, the machines being *capable of building up grease pressure* of more than five thousand pounds per square inch." (R-II 1044.)

As pointed out in the Petition, the Baldner grease-dispensing machine also was capable of building up grease pressure of more than five thousand pounds per square inch. On actual demonstration in court the Baldner machine produced a higher pressure than the defendant-respondent's machine, reaching **7000** pounds pressure per square inch. (R-I 224.)

That the forcing of grease through a hose is an old and well known function of a grease compressor and that a high pressure can be built up in a hose in opposition to resistance to flow, has been fully recognized by this Court, as for example:

"By the downward stroke of the plunger the entrance to the pump chamber is closed and the grease therein forced *into the hose* and through the *coupling* and pin *fitting* to the bearing. By successive strokes a very *high pressure can be built up* in the hose." *Rogers vs. Alemite,* 298 U. S. 415, 422.

This Court has likewise recognized the fact that the adding of a hose does not alter the function of the pump or grease-compressor:

"The function of a pump has *always been to force a fluid or a grease through a conduit.* The fact that this function of the pump is *utilized* in Butler's improved form of coupler not only to convey the lubricant to the bearing but to operate the jaws of the chuck *does not alter* the function of the pump." *Lincoln vs. Stewart-Warner,* 303 U. S. 545, 551.

Argument on the Second Conflict:

As pointed out in the Petition, Baldner's patent specification, besides showing, describing and claiming his power driven two-stage grease-dispensing machine also shows and describes a small meter or dial and an electrical switch controlling circuit which may be optionally superimposed upon the grease-dispensing machine, in order to indicate or register the total amount of grease dispensed or delivered by the grease-dispensing machine. In other words, the Baldner specification not only showed and described his novel two-stage grease-dispensing machine or "grease-gun" but also showed and described a tachometer to count the number of cycles or strokes of his booster pump. There has been no charge that the defendant-respondent has used the small meter, dial or gauge, or the electrical control circuit which are disclosed in the patent specification. The charge of infringement is directed to the large grease-dispensing machine, *per se*. The Baldner grease-compressor and the defendant-respondent's compressor are structurally equivalent. The parts of one machine are readily interchangeable with the corresponding parts of the other machine.

The counting dial and the electrical controlling circuit in the Baldner specification are not included in the claims 2, 3, 4 and 13 in suit. Notwithstanding this fact, however, the Circuit Court of Appeals excused the "Rock Crushers" from infringement in the following language:

> "The 'Alemite Rock Crushers' are never sold as *metering* or measuring devices, and could not be so used. * * * There is *no meter or gauge* of any kind *included* in the structure which is used or usable to measure the quantity of grease discharged, and in lubricating a car there is *no way of knowing* how many cubic inches of lubricant may be used." (R-II 1044.)
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> "Assuming without conceding that the accused structures, *so far as they go*, use precisely the *same means* as the patent uses, yet appellee could not be

held for infringement, for Baldner has *no patent* on anything *less* than his *entire combination.*" (R-II 1046.)

This ruling that the accused "Rock Crushers" avoid the charge of infringement because they do not include a meter, gauge or other counting or indicating mechanism, was made in face of the fact that the claims in suit do not include nor attempt to include, nor has it been asserted or found that they do include, any such meter, gauge or other counting or indicating mechanism, as for example claim 3 of the patent:

> "3. In an apparatus of the character described, a reservoir, an ejector communicating therewith dividing the discharged material into successive charges of known capacity and conveyor means for supplying the material to the ejector in quantity greater than its capacity whereby said ejector will act to impede the normal flow of the material under influence of the first ejector and will be operated at full capacity to discharge the material in known measured quantity."

The "measured quantity" last referred to in the claim is in the *singular* rather than in the plural. The action of the booster or ejector described in the claim is a single cycle or stroke action ejecting one full "shot" of grease. The measured quantity discharged in this one action is an increment in an amount determined by the fixed capacity or size of the booster or ejector chamber, provided, of course, that the booster or ejector chamber has been *completely filled* with solid grease. There is *no* reference in the claim to a computation or tabulation of the *total* amount of grease, in pounds or quarts, which may be dispensed by a series of counted or determined number of cycles or strokes of the ejecting piston of the booster. Both the patented grease-dispensing machine and the accused grease-dispensing machine have their respective booster chambers *completely filled* with grease and discharge the grease in the full measured quantity fixed by the volumetric capacity or size of the booster chamber, as called for by example claim 3.

The method of operation of both the Baldner grease-compressor and the accused grease-compressor is the same, in that when the pump or ejector piston is retracted or actuated beyond the intake orifice communicating with the supply reservoir, grease is forced into the pump chamber by the screw-conveyor in the supply reservoir. The pump or ejector chambers are of a *fixed volume or known capacity.* By the discharge stroke or movement of the pump or ejector piston, the entrance to the pump or ejector chamber is closed and *all* of the grease entrapped therein is forcibly discharged into the hose. Thus, upon each successive discharge stroke or movement of the piston, the grease is divided into charges of a *fixed or known quantity,* as called for in the claim 3 and others. The screw-conveyor supplies the grease to the pump or ejector chamber in quantities greater than its capacity or fixed volume. The pump or ejector impedes the normal flow of the advanced grease and enables the screw-conveyor to pack the grease *solid* against the intake orifice of the pump or ejector chamber to expel or churn out the air contained in the air pockets of the grease. This prevents the pump or ejector from becoming "air bound." As a result, the pump or ejector chamber is always filled with *solid* grease and is operated at *full capacity* devoid of air pockets. The entrapped grease in the pump or ejector chamber being solid and the pump or ejector chamber being of a fixed or known capacity, insures that the material upon each successive discharge stroke or movement of the piston is of a *known measured quantity,* as called for in the claim 3 and others. From the above, it is clearly evident that the claim 3, for example, does not include nor attempt to include, nor has it been asserted or found that it does include, any meter, gauge or other counting or indicating mechanism.

Thus, the Baldner patent disclosure comprises two parts, one describing the two-stage grease compressor and the other describing the meter, dial or registering mechanism. The Circuit Court of Appeals disregarded the claims

in suit and took the "entire specification" as the measure of the patent. This Court has explicitly held that it is the *claims* of a patent which define an invention and that therefore the *separate claims* must be examined to determine whether there has been an infringement of the patented invention. This Court has stated:

> "The Court of Appeals, in upholding the patent, made no examination of its *separate claims,* but treated the patent throughout as though it were a combination of five distinct elements, the photoelectric cell, the arcuate flexing of the film, the flywheel, the flexible connection of the flywheel and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. Under the statute it is the *claims* of the patent which define the invention." *Altoona Theaters vs. Tri-Ergon Corporation,* 294 U. S. 477, 487.

Some claims may be directed to an entire combination and other claims of the same patent may be directed to but a part of that entire combination in order to protect the invention residing in that individual part, for claims are separable and cover independent inventions. The entire combination disclosed in the entire specification need not be appropriated to constitute infringement of claims confined to but a part of the entire combination.

> "Besides, a patent may embrace more than one invention. *Steinmetz v. Allen,* 192 U. S. 543. A process and an apparatus by which it is performed are distinct things. They may be found in one patent; they may be made the subject of different patents. So may other dependent and related inventions.
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> "A combination is a union of elements, which may be partly old and partly new, or wholly old or wholly new. But whether new or old, the combination is a means—an invention—distinct from them. They, if new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they *are not identical* with the combination.

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"Claims are *independent* inventions. One may be infringed, others not, and the redress of the patentee is limited to the injury he suffers, not by the abstract rights which have been granted him in other claims. One claim may be valid, all the rest invalid; invalid for the want of some essential patentable attribute. But what is good remains and is unaffected by its illegal associates. In such cases the patent does not stand or fall as a unity. If claims may be separable as in the case of infringement of some and not of others; if claims can be separable, though some are invalid, may they not be separable when some of them have expired?" *Leeds and Catlin vs. Victor Talking Machine Co.*, 213 U. S. 301, 318, 319.

In the face of, and in direct violation of, this Court's statement of the principle of patent law that it is the claims of a patent which measure the patented invention and determine the scope of the patent monopoly, the Seventh Circuit Court of Appeals in the case at bar expressly decided that:

"Assuming without conceding that the accused structures, *so far as they go,* use precisely the *same means* as the patent uses, yet appellee could not be held for infringement, for *Baldner has no patent* on anything less than his *entire combination.*" (R-II 1046)

This Court has specifically laid down the rule that the *claims* of a patent must be examined to determine whether there has been an infringement of the patented invention because the claims are of primary importance in the determination of the invention that is patented. Nor are the claims to be twisted so as to include something different from that which their words express. This rule has been stated as follows:

> "Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express." *White vs. Dunbar,* 119 U. S. 47, 51.

An inventor is not confined to the detailed description set forth in the entire patent specification as this detailed description merely sets forth a preferred or suggested mode of applying the invention. This well established principle was expressly recognized by this Court in the following language:

> "We think it is clear that the court considered that Liddell sought to comply with Section 4888 of the Revised Statutes. In other words, he filed a description of his invention, explained its principle and the best mode in which he 'contemplated applying that principle,' and did not intend to give up all other modes of application. An inventor must describe what he conceives to be the best mode, but he is not confined to that. *If this were not so most patents would be of little worth." Continental Paper Bag Co. v. Eastern Paper Bag Co.,* 210 U. S. 405, 418.

CONCLUSION.

In conclusion, it is submitted that the decision and judgment of the Court of Appeals for the Seventh Circuit should be reviewed and reversed by this Court as being in direct conflict with the applicable decisions of this Court and as being completely contrary to the vitally important principles of patent law established by the decisions of this Court, and that therefore the writ of certiorari should be granted.

Respectfully submitted,

KENNETH S. CLAPP,

By BRUCE B. KROST,

Counsel for Petitioner.